

REMARKS/ARGUMENTS

Summary:

Claims 1, 3-6, 8-15, 19-22, and 24 are presently pending in this application. Claims 1 and 9 have been amended. Claims 2 and 7 have been canceled. Applicant respectfully requests that the Examiner favorably reconsider and allow the pending claims.

35 U.S.C. §103 Rejection:

At page 2, paragraph 3 of the Office Action, claims 1-15, 19-22, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,330,577 to Kim in view of U.S. Pat. No. 6,687,879 to Teshima. Applicant respectfully traverses the rejection, and requests that the Examiner reconsider and withdraw the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP §2143, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” Further, MPEP §706.02(j) (*citing Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)) recites:

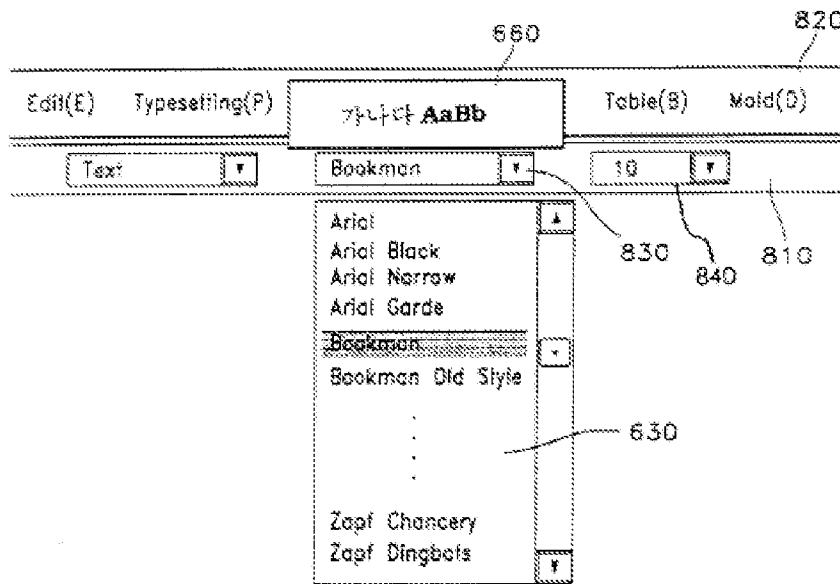
To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention top be obvious in light of the teachings of the references.

At page 2-9, paragraph 3 the Office alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Teshima to Kim. However, Applicants respectfully submit that the Office Action has not established a *prima facie*

case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited by currently amended independent claims 1 and 9. For example, currently amended independent claim 1 recites, *inter alia*:

. . . concurrently displaying the same text, including the same plural characters in the first order, in a second font format differing from the first font format in the font preview display area wherein
the text displayed in the first font format and the second font format includes the same text in a single language, and
the text displayed in the first font format and the second font format is displayed in a paragraph display or waterfall display format.

Currently amended independent claim 9 recites at least a similar element. Regarding canceled dependent claim 2, at least an element of which has been included in currently amended independent claims 1 and 9, the Examiner alleges that Kim Figure 8 and element 660 teaches that the text is displayed in a paragraph display format. Applicant respectfully disagrees. For example, Figure 8, reproduced in part below, illustrates the temporary font preview window (i.e., element 660):



Kim column 3 lines 61-65 recite that “[w]hen a user moves a pointer (not shown) over a desired one of the font names (for example, ‘Arial’) among the font names, the corresponding font sample (for example ‘ABCabc’) is output to the preview window 660, without the user having to click the mouse.” Kim column 4 lines 46-47 recite that step S752 determines “. . . whether the preview window 660 is open, as shown in FIG. 8 on menu bar 820, or closed.” If the preview window 660 is closed, Kim column 4 lines 53-56 recite that the “. . . preview window 660 has to be generated and displayed on menu bar 820 for outputting the font sample, which corresponds to the selected font.” Applicant asserts that Kim discloses only that the preview window 660 is displayed on menu bar 820. As the size of the menu bar 820 according to Kim would prohibit the preview window 660 from displaying more than a limited (e.g., “ABCabc,” “ABCabc123”) font sample of a particular size and style to avoid obstructing the menu bar 820 and/or tool bar 810 from which the user will select a font, Applicant asserts that currently amended independent claims 1 and 9 are therefore patentable as Kim in view of Teshima, either taken alone or in combination, do not teach the text displayed in the first font format and the second font format is displayed in a paragraph display or waterfall display format as recited by currently amended independent claims 1 and 9 (*See* at least page 11 paragraph 1 and FIG. 3C of the as-filed specification).

Regarding canceled dependent claim 7, at least an element of which has been included in currently amended independent claims 1 and 9, the Examiner alleges that Kim Figure 8 elements 830, 840, and 810 teach that the text is displayed in a waterfall display format. Applicant respectfully disagrees. Applicant asserts that element 810 is the tool bar, element 830 is the font

combo box (from which the user may select a single font to preview) and element 840 is the font size controller (from which the user may select one font size to preview. The cited elements 810, 830, and 840 merely allow a user to select a particular font and size to be previewed by font preview window 660. As noted above, the size of the menu bar 820 according to Kim would prohibit the preview window 660 from displaying more than a limited (e.g., “ABCabc,” “ABCabc123”) font sample of a particular size and style to avoid obstructing the menu bar 820 and/or tool bar 810 from which the user will select a font. Applicant therefore asserts that Kim in view of Teshima, either taken alone or in combination, does not teach that the text displayed in the first font format and the second font format is displayed in a paragraph display or waterfall display format (*See* at least page 11 paragraph 2 and FIG. 3D of the as-filed specification). Accordingly currently amended independent claims 1 and 9 are patentable as each recites at least an element not taught by Kim in view of Teshima either taken alone or in combination. Dependent claims 3-8, 10-15, 19-22, and 24 are patentable as each depends from patentable independent claims 1 and 9.

CONCLUSION

For at least the foregoing reasons, Applicant submits that he has overcome the Examiner's rejections and that he has the right to claim the invention as set forth in the listed claims 1, 3-6, 8-15, 19-22, and 24. The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above.

Applicant respectfully requests further examination on the merits of this application.

Please charge all fees in connection with this communication to Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: /Jon C. Reali/
Jon C. Reali
Registration No. 54,391

BANNER & WITCOFF, LTD.
1100 13th Street, N.W., Suite 1200
Washington, D.C. 20005
(503) 425-6800
Dated: August 12, 2008